

REMARKS

Claim 32 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse this rejection.

Applicants have amended Claim 32 to clarify that the element referred to is the “means for guiding the marking,” which is defined in associated independent Claim 1 in line 4. Accordingly, as the antecedent basis problem has been corrected, withdrawal of this rejection is respectfully requested.

Claims 1, 7, 30, 32 and 33 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by United States Patent No. 5,156,162 to Gerhardt. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Gerhardt reference fails to disclose all of the features of the present invention. More specifically, the Gerhardt reference fails to disclose a measuring guide or device that includes, *inter alia*, a pivotable stop plate. This feature, which was originally found in now-cancelled dependent Claims 2 and 31, has been added to independent Claims 1 and 30. Since Claims 2 and 31 were not rejected under Gerhardt, Applicants submit that the Examiner correctly realized that plate 18 of Gerhardt is not pivotable. Accordingly, as all of the features of amended independent Claims 1 and 30 are not disclosed in Gerhardt, Applicants respectfully request the withdrawal of this §102 rejection of Claims 1 and 30 and associated dependent Claims 7, 32 and 33.

Claim 10 stands rejected under 35 U.S.C. § 102 (b) as being anticipated by United States Patent No. 4,220,163 to Malek Afzali. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Malek Afzali reference fails to disclose all of the features of the present invention as defined in independent Claim 10. More specifically, the Malek Afzali reference fails to disclose a measuring guide that includes, *inter alia*, a noninvasive stop plate that is coupled to the ruler and is “pivotable, with respect to a pivot point on the ruler,” as defined in independent Claim 10. One example of an embodiment of Applicants’ invention that includes this feature is shown in Applicants’ Figures 3, 4 and 14, which show how stop plate 30 is pivotable with respect to a pivot point on ruler 22. In contrast, in the device of Figure 1 of the Malek Afzali reference, member 2, which the examiner identified as the claimed stop plate, is not pivotable with respect to a pivot point on member 8, which the Examiner identified as the claimed ruler. Instead, member 2 is pivotable with respect to a pivot point that is *adjacent* to member 2 (and not *on* member 2). Accordingly, as all of the features of Claim 10 are not disclosed in the Malek Afzali reference, Applicants respectfully request the withdrawal of this § 102(b) rejection of Claim 10.

Claims 1-7, 10, 11, 16-18 and 30-35 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by United States Patent No. 5,364,401 to Ferrante et al. Claims 2, 11 and 31 have been cancelled, thereby rendering this rejection moot with respect to these

claims. However, with respect to Claims 1, 3-7, 10, 16-18, 30 and 32-35, Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Ferrante et al. reference fails to disclose all of the features of the present invention. More specifically, the Ferrante et al. reference fails to disclose a measuring guide that includes, *inter alia*, a ruler that indicates “the distance between the marking guide and the stop plate,” as defined in independent Claims 1 and 10. Nor does the Ferrante et al. reference disclose a system for utilizing a measuring device that includes, *inter alia*, a ruler that indicates “the distance between the means for abutting and the means for guiding,” as defined in independent Claim 30.

One example of an embodiment of Applicants’ invention as defined in Claims 1, 10, and 30 is shown in Applicants’ Figure 1, which includes a ruler 22 that indicates the distance between the marking guide 24 (“means for guiding the marking”) and the stop plate 30 (“means for abutting an end of the desired bone”).

In contrast to the present invention, the ruler of 30 of the Ferrante et al. reference does not indicate the distance between a marking guide (a “means for guiding the marking”) and a stop plate (a “means for abutting”). In other words, as shown in Figure 3 of Ferrante et al., the ruler 30 of the Ferrante et al. reference does not indicate the distance between component 46, which the Examiner equated with the claimed marking guide (“means for guiding the marking”) and component 96, which the Examiner equated with the claimed stop plate (“means for abutting”). Instead, ruler 30 of the Ferrante et al. reference

indicate the amount of relative axial movement between brackets 20 and 22 (Figure 1), as described in column 3, lines 22-28. Accordingly, as all of the features of independent Claims 1, 10 and 30 are not disclosed in the Ferrante et al. reference, Applicants respectfully request the withdrawal of this §102 (b) rejection of Claims 1, 10 and 30, and of associated dependent Claims 3-7, 16-18, and 32-35.

Claims 1, 7, 10, 11, 16, 17, 19-26, 28 and 30-35 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by United States Patent No. 5,486,178 to Hodge. Claims 11 and 31 have been cancelled, thereby rendering this rejection moot with respect to these claims. However, with respect to Claims 1, 7, 10, 16, 17, 19-26, 28, 30 and 32-35, Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Hodge reference fails to disclose all of the features of the present invention. More specifically, the Hodge reference fails to disclose a measuring guide, as defined in independent Claims 1 and 10, that includes, *inter alia*, a ruler that indicates “the distance between the [noninvasive] marking guide and the [noninvasive] stop plate.” Similarly, the Hodge reference fails to disclose the system for utilizing a measuring device, as defined in independent Claim 30, that includes, *inter alia*, a ruler that indicates “the distance between the means for abutting and the means for guiding.” Additionally, the Hodge reference fails to disclose the method for utilizing a measuring device, as defined in independent Claim 19, that includes, *inter alia*, a step of “reading, from

the ruler, the distance between the noninvasive stop plate and the noninvasive marking guide.”

In contrast to the ruler of the present invention, which indicates the distance between the stop plate (or means for abutting) and the marking guide (or means for guiding), the ruler 100 of the Hodge reference indicates available sizes of femoral knee prostheses (*see* col. 5, lines 24-26). Accordingly, ruler 100 of the Hodge reference does not show the distance between member 50, which the Examiner equated with the claimed stop plate, and member 94, which the Examiner equated with the claimed marking guide. Thus, as all of the features of independent Claims 1, 10, 19 and 30 are not disclosed in the Hodge reference, Applicants respectfully request the withdrawal of this § 102 (b) rejection of independent Claims 1, 10, 19 and 30, and associated dependent Claims 7, 16, 17, 20-26, 28, and 32-35.

Claims 8 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Gerhardt reference in view of United States Patent No. 6,648,891 to Kim. Applicants respectfully traverse this rejection.

Claims 8 and 9 both depend, directly or indirectly, from independent Claim 1, and therefore include all of the features of Claim 1, plus additional features. Accordingly, Applicants respectfully request that the § 103 rejection of dependent Claims 8 and 9 under the Gerhardt reference in view of the Kim reference be withdrawn considering the above remarks directed to the § 102 (b) rejection of independent Claim 1 under Gerhardt, and also

because the Kim reference does not remedy the deficiency discussed above, nor was it relied upon as such.

Claims 8, 9 and 12-15 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Ferrante et al. reference in view of United States Patent No. 5,997,545 to Doherty et al. Applicants respectfully traverse this rejection.

Claims 8, 9 and 12-15 all depend, directly or indirectly, from either independent Claim 1 or from independent Claim 10, and therefore include all of the features of either Claim 1 or of Claim 10, plus additional features. Accordingly, Applicants respectfully request that the § 103 rejection of dependent Claims 8, 9 and 12-15 under the Ferrante et al. reference in view of the Doherty et al. reference be withdrawn considering the above remarks directed to the § 102 (b) rejection of independent Claims 1 and 10 under Ferrante et al., and also because the Doherty et al. reference does not remedy the deficiency discussed above, nor was it relied upon as such.

Finally, Applicants have also added new dependent Claims 36-38, which all depend from either independent Claim 1 or from independent Claim 10. Applicants respectfully submit that new Claims 36-38 are allowable for at least the reasons discussed above with respect to their associated base claims.

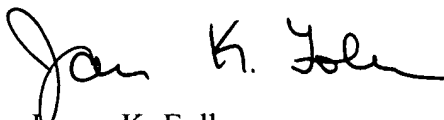
For all of the above reasons, Applicants request reconsideration and allowance of the claimed invention. Should the Examiner be of the opinion that a telephone conference

would aid in the prosecution of the application, or that outstanding issues exist, the Examiner is invited to contact the undersigned.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By

A handwritten signature in black ink, appearing to read "Jan K. Folker", written over the printed name.

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